

Remarks/arguments

Claims 1, 8, 11, and 18 have been amended. Claims 2, 4, 5, 12, 14, and 15 have been deleted. Claims 1, 3, 6 through 11, 13, and 16 through 20 remain in the application. Reexamination and reconsideration of the application are requested in view of applicant arguments.

The examiner has rejected claims 1, 3 through 5, 9, 11, 13 through 15 and 19 under 35USC103 as being unpatentable over Bickel, et. al. The examiner states that Bickel discloses the elements of claim 1, however, fails to clearly disclose the use of plurality of weights. He goes on to state the specification provides no unanticipated or surprise result from the plurality of weights, therefore, it is considered a design of choice. The applicant transverses this statement. The applicant does not understand this statement. The claim itself puts forth the reason for the plurality of weights. The second element of the claim states "a plurality of weight members that can be placed within the bore of said tubular member or it can be fully removed from the bore of said tubular member and these weights allow an individual to change the weights of the tubular member and make the tubular member similar in weight to a conventional bat. Thus, the claim itself states that one

of the reasons for the plurality of weights is that the individual can change the weight of the bat. It also states that the individual can make the weight similar to the weight of his conventional bat. On page 5 of the specifications, finds 18 and 19 the applicant puts forth "another objective is to provide a training bat system that may be utilized by individuals of various ages, sizes and skill level." The statement clearly puts forth the reasons for using the plurality of the weights and the ability to change the weight of the bat. On page 10, line 4 through 7, the applicant states "The weight members 60 are preferably comprised of various lengths and weights to allow for the user to balance the tubular member 20 to simulate the weight and balance of their regular bat he would use in a game" Here again the applicant states that the plurality of weights are designed so that the individual can change the weight of the bat and make it weigh similar to his conventional bat. Thus, applicant clearly puts forth the reasons for the plurality of weights. That reason is clearly differ from the reason of the "weight" in Bickel. The reasons for the plurality weights are clearly not an obvious design equivalent means. It should be noted that Bickel actually teaches a way from applicants bat. Applicant stated that the plurality of weight is to make the bat weigh similar to the one the individual would use during the game or heavier. Bickel states that in paragraph marked 0007 "a

second goal was to create a light weight device. Repeated strings with a standard weight bat can produce muscle fatigue and possibly even injure. Repeated repetition in a fatigued state does not build the proper muscle memory so it is important that the training aid be light weight ". Thus, Bickel teaches a bat to be lighter than one an individual normally uses.

Secondly, it should be noted that using a plurality of weights in Bickel would destroy the main objective of Bickel's system. Bickel states that the goal in 0006 of his bat "the goal was to create a device that would only make a distinct noise at the proper point of bat contact with a pitched ball, the point of full extension. The batter's swing is very fast and thus difficult to visually examine and evaluate, even for an experienced hitter hitting instructor. Your ears are very accurate at locating a point where the snap occurs. This promotes muscle memory teaching the point for the hitters". If more than one weight was actually used, you would get more than one snap in this bat. This would clearly not promote a muscle memory teaching point for hitters. Applicant would like the examiner to show how the plurality of weights can be added to Bickel without destroying its purpose. A 103 rejection based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, is not proper because there would be no technological motivation for engaging in the

modification. See In re Gordon 7333 F 2d. 900, 221 USPO 1125 (FED. CIR. 1984)

Claim 1 has been amended. The words "are adapted to fit within the bore and" have been added in the second element after the word "that." Also in the second element the words "and said weighted members vary in length and weight, said weighted members are positionable within the boar such that an individual placing the weights within the bat can make any section of the tubular lighter or heaver to" have been add for the word "and". After the last "weight" the words "and balance" have been added. A new element which reads " a means to compress said weighted members within said boar to ensure that the weights do not move; and," has been added. Basis for this is found in the specification on page 10 line 1 through 19. This make claim 1 clearly patentable over Bickel in that the claim call for a nonmovable weight. In Bickel the weight moves. Thus claim 1 is clearly patentable over Bickel.

Claims 4 and 5 have been canceled. Claims 3 and 9 are all dependent upon claim 1, thus the same argument that applies to claim 1 would also apply to claims 3 and 9. Thus, claims 3 and 9 are clearly patentable over Bickel.

Claim 11 has been amended. Claim 11 has been made dependent upon claim 1. The first three elements of the original claim 1 have been deleted. Thus the claim only keeps the last element of the original claim 1. Since claim 11 is now only dependant upon claim 1, the same argument that applies to claim 1 would also apply to claim 11 and make claim 11 patentable over Bickel.

Claims 13 through 15 and 19 are all ultimately dependent upon claim 11 and claim 1, thus, the same argument that applies to claim 1 and 11 would also apply to claims 13 through 15 and 19.

The Examiner has rejected claims 1 through 8 and 11 through 18 under 35 USC 103(a) as being unpatentable over Owen et al in view of Pomila. The Examiner states that Owen discloses the elements of claim 1, however does not disclose the use of a bat with a uniform outer diameter. Pomila discloses the use of a bat with a uniform outer diameter. The examiner goes on to say that it would have been obvious to one of ordinary skill in the art to have selected the bat shape disclosed in Pomila in order to reduce material costs.

Applicant states that the combination of Owen and Pomila does not show one of the elements of claim 1. As I stated before neither Owen or Pomila show a "bore extending within from an inner end to a distal end of

said tubular member" as called for in claim 1. Owen shows a short bore at the top of the bat and Pomila does not show a boar. Examiner has stated tha Pomila show a bore. This is true only if the foam is removed and applicant believes that the foam is an integral part of the Pomila patent. Without it the plastic shell could not be used as a bat. It should be noted that the examiner does not use Pomila to show the bore only to show the outer shape of the bat. This is probably because Pomila uses the foam to have the bat weight a consistent weight through its whole length. Applicant bat is specifically design to vary in weight through its whole length so that it will be balanced and feel like a conventional bat. Thus claim one is patentable over Owen in view of Pomila because Owen does not show a boar that extends the full length of the bat.

Further claim 1 as now amended calls for weighted members varying in length and weight so that the individual placing the weights within the bat can vary the weight of any section of the bat to make its weight and balance similar to a conventional bat. Owen does not show weights of varying length or weight. Weights of Owen's bat are add to make the bat heaver than a conventional bat. The combination of Owen and Pomila actually teaches away in that Pomila is designing a bat that is the same weight per section

thought the whole bat. Thus claim 1 is clearly patentable over Owen in view of Pomila.

The examiner reliance on *In re Harza* is misguided. Applicant believes that the examiner did not understand that applicant was trying to create a bat the felt exactly like a conventional bat. *In re Harza* has two patents that call for a water seal that are sealed by different designed. Thus the reason for the seal is the same in both patents. Thus the court states that the inventor must prove that his seal has some advantage over the older seal. In our case Bickel weight is moveable and light so as to not cause muscle fatigue and to teach young ballplayer to "break there wrist" when swing. Owen weights are to increase the weight of the bat to build up muscle strength. Pomila foam is to have the same weight per cubic inch thought out the bat and to make the bat heaver to build up muscle strength. In Claim 1 the reason one has a plurality of weight of varying length and weight is to make the bat feel, and be balanced as a conventional bat. Thus as four patents have a different reason for there weighted member. This case is clearly substantially different than Herza.

Claim 11 as amended is now dependant on claim 1, thus claim 11 would be patentable over Owen in view of Pomila for the same reasons claim 1 is patentable over Owen in view of Pomila. Claim 11 also call for a

cap on both ends of the bat to hold the weights within. Owens has a cap only on one end to hold the weights within and Pomila has no caps to hold the weights within. Thus clearly claim 11 is patentable over Owen in view of Pomila.

Claim 2 and 12 have been canceled. As to claim 3 and 13 the examiner states that Owen discloses a bore of consistent diameter. Claims 3 and 13 are ultimately dependant on claim 1. Thus the same argument that applies to claim 1 and 11 also applies to claims 3 and 13. Thus clearly claims 3 and 13 are patentable over Owen in view of Pomila.

Claims 4, 5, 14, and 15 have been cancelled. Claim 8 and 18 have been amended. The word "including" has been deleted and replaced with the words "wherein the means for compressing is."

Claims 6, 7, 8, 16, 17, and 18 are ultimately dependant on claim 1. Thus the same argument that applies to claim 1 also applies to claims 6, 7, 8, 16, 17, and 18. Thus clearly claims 6, 7, 8, 16, 17, and 18 are patentable over Owen in view of Pomila.

The examiner states as to claims 10 and 20 are unpatentable over Owen in view of Pomila and Nelson. Applicant states Claims 10 and 20 are dependant on claim 1 or 11. Thus the same argument that applies to claim 1 and 11 also applies to claims 10 and 20 as to Owen and Pomila. Applicant is

not exactly certain how Nelson is used by the examiner. Applicant believe that examiner is replacing the wood of Owen for aluminum of Nelson. This however would not create a bore that extends form one end of the tube to the other. Thus claims 10 and 20 are clearly patentable over Owen in view of Pomila and Nelson.

As to claims 9 and 19 Examiner states that they are unpatentable over Owen in view of Pomila as to the argument as to claim 1 and further inview of Blum. Blum shows a bat made out of plastic. Applicant assumes that examiner is replacing the wood of Owen for the plastic of Blum. This however would not create a bore that extends form one end of the tube to the other. Thus claims 10 and 20 are clearly patentable over Owen in view of Pomila and Blum

As to claims 10 and 20 Examiner states that they are unpatentable over Owen in view of Pomila as to the argument as to claim 1 and further in view of Merritt. Merritt shows a bat made out of aluminum. Applicant assumes that examiner is replacing the wood of Owen for the aluminum of Merritt. This however would not create a bore that extends form one end of the tube to the other. Thus claims 10 and 20 are clearly patentable over Owen in view of Pomila and Merritt.

Furthermore, it is believed the claims define an invention which is unobvious over all US patents to Owen, Pomila, Blum, Bickel, Nelson and Merritt, taken singularly or in combination. None of these references show weighted members that can be positioned within the tubular member that can make the tubular member of similar weight and balance to a conventional bat.

In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration of the rejection and objections is requested. Allowance of claims 1, 3, 6 through 11, 13, and 16 through 20 at an early date is solicited.

Respectfully submitted,



Jerry Semer
Attorney at Law
617 Croghan Street
Fremont, Ohio 43420
419-332-2221
#33,087